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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,904	12/08/2000	Koichiro Kishima	SON-2029	1187

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/731,904

Applicant(s)

KISHIMA ET AL.

Examiner

Lawrence D Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 19-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 35 and 38-41 is/are rejected.
- 7) ☒ Claim(s) 36-37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Election***

1. This action is in response to the provisional election mailed May 28, 2002.  
(Group I) Claims 1-18 were provisionally elected rendering (Group II) Claims 19-34 to a non-elected species.

### ***RESPONSE TO REQUEST FOR RECONSIDERATION***

2. Applicant's election with traverse of method of making an optical recording medium (Group II) is acknowledged. The traversal is on the ground(s) that 'if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims distinct or independent inventions.' M.P.E.P. 803. Additionally, 'not only must the art be searched within which the invention is claimed, but also all analogous arts' M.P.E.P. 904.01(c). The search of the 2 classes and subclasses would entail the requisite serious burden as the search for method of making is not the same as the article search. Additionally, the steps used in the method claims would not be expected to appear in the class/subclass of the product claims. Every optical disk is not made using the same method steps. Applicant requests rejoinder of Group I invention and Group II invention under M.P.E.P. 821.04. Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f)

and § 806.05(h). The claims to the non-elected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. The requirement is deemed proper and is therefore made **FINAL**.

### ***Response to Amendment***

3. This action is in response to the amendment mailed May 28, 2002. Claims 1 and 9 were amended, claims 35 – 41 were added rendering claims 1-18 and 35-41 pending with claims 19-34 held to a non-elected invention.

### ***Claim Rejections – 35 USC 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In Claim 12, "high level of flatness" is indefinite. High is a relative term and is therefore indefinite.

***Claim Rejections – 35 USC § 103(a)***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-17, 35 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawakubo et al. (U.S. 5,972,459) in view of Yamada et al (U.S. 5,635,267) for the reasons set forth in paragraph 10, in the previous office action, mailed April 02, 2002. Regarding newly added limitations of claims 35 and 38-41, the prior art of Kawakubo includes such limitation(s) because it would have been obvious to one of ordinary skill in the art that the light transmission flattenable film is *capable* of being polished because the optical recording medium is made of the same components having the same function as Applicant's. Additionally, Kawakubo discloses an optical disk comprising a reflective film layer, a first dielectric layer and a phase change recording layer which are formed on the substrate (column 9, lines 7-11). Applicant claims a backing layer above the film layer, the light transmission flattenable layer above the backing layer and the surface layer above the light transmission flattenable layer. The prior art meets the claim limitations except for the order the layers are arranged in. It would have been obvious to one of ordinary skill in the art to arrange the layers as Applicant claims because rearranging parts of an invention involves only routine skill in the art. *In re Japinske*, 86 USPQ 70.

***Claim Rejections – 35 USC § 103(a)***

8. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawakubo et al. (U.S. 5,972,459) in view of Yamada et al (U.S. 5,635,267) further in view of Sekiya et al (U.S. 5,614,287) for the reasons set forth in paragraph 12, in the previous office action, mailed April 02, 2002. Applicant claims a backing layer above the film layer, the light transmission flattenable layer above the backing layer and the surface layer above the light transmission flattenable layer. The prior art meets the claim limitations except for the order the layers are arranged in. It would have been obvious to one of ordinary skill in the art to arrange the layers as Applicant claims because rearranging parts of an invention involves only routine skill in the art. *In re Japinske*, 86 USPQ 70.

9. Claims 36 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

10. Applicant's traversal to 35 USC 112, second paragraph have overcome the rejection and the rejection(s) have been withdrawn in regards to the term 'flattenable' and the indefinite claim language of claim 9 has been removed via amendment.

Applicant fails to address the indefiniteness of claim 12, in regards to, 'high level of flatness'. Therefore the rejection is upheld.

Applicant's arguments of rejection under unpatentable over Kawakubo et al. (U.S. 5,972,459) in view of Yamada et al (U.S. 5,635,267) and Kawakubo et al. (U.S. 5,972,459) in view of Yamada et al (U.S. 5,635,267) further in view of Sekiya et al (U.S. 5,614,287) have been considered but are unpersuasive. Applicant argues within the amended claims includes a backing layer above the film layer, the light transmission flattenable layer above the backing layer and the surface layer above the light transmission flattenable layer. The prior art meets the claim limitations except for the order the layers are arranged in. It would have been obvious to one of ordinary skill in the art to arrange the layers as Applicant claims because rearranging parts of an invention involves only routine skill in the art. *In re Japinske*, 86 USPQ 70.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

  
Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

